

**Office Action Summary**

Application No.

10/037,545

Applicant(s)

OUCHI ET AL.

Examiner

George C. Neurauter, Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 and 31-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 31-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

Claims 1-8 and 31-41 are currently presented and have been examined.

***Response to Arguments***

Applicant's arguments filed 16 October 2007 have been fully considered but they are not persuasive.

The Applicant argues that claim 1 is not subject to obviousness-type double patenting over claim 2 of US Patent 5,978,836 to Ouchi since Ouchi fails to describe sending the email "without the route". This is not persuasive since claim 2 of Ouchi does not describe sending an email with a route. Therefore, claim 1 of the instant application continues to be rejected under the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 2 of U.S. Patent No. 5,978,836.

The Applicant also argues that claim 2 is not subject to obviousness-type double patenting over claim 2 of US Patent 5,978,836 to Ouchi since Ouchi fails to describe a form route manager for managing a project to role to small address table. As noted previously, the project to role to email address table lacks any functional or structural relationship with any element within the claim, therefore, its inclusion would not create a patentable distinction from claim 2 of Ouchi. Furthermore, the

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recitation of the "project to role to small address table" occurs in the preamble and, especially in view of the above, fails to breathe any life into the claim itself and therefore is considered to have no patentable weight. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Therefore, the scope of each claim is the same and claim 2 of the instant application continues to be rejected under the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 2 of U.S. Patent No. 5,978,836.

Claims 3-8, 31, 33-35 and 37-38 also continue to be rejected under the ground of nonstatutory obviousness-type double patenting for the reasons shown above regarding claims 1 and 2 of the instant application.

The Applicant also disagrees with the Examiner's finding of the inherent teaching within "Project 2000". The Examiner maintains the views as previously presented. As explained previously, the inherent features in "Project 2000" that are

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shown to correspond with the claimed invention would necessarily have to exist since the invention of "Project 2000" would NOT be able to operate otherwise. Therefore, it is submitted that a proper case for inherency has been presented in the previous Office Actions.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-8 and 31 and also claims 33-35 and 37-38 by way of their dependency from claim 31 are rejected on the ground of nonstatutory obviousness-type double patenting as being

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unpatentable over claim 2 of U.S. Patent No. 5,978,836.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of the instant application recites substantially the same limitations as in claim 2 of U.S. Patent No. 5,978,836. Further, claim 2 of the instant application recites substantially the same limitations as recited in claim 2 of U.S. Patent No. 5,978,836, however, claim 2 of the instant application does not recite a project to role to email address table which, in view of its lack of functional interrelationship with any element within the claim, would not be patentably distinct from claim 2 of U.S. Patent No. 5,978,836.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 39-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 39-41 recite "compare a step field of the email with the route" and "update the step field to the next step". It is

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unclear whether the step field is within the email or within or a part of some other element. Also, the limitation "the next step" has insufficient antecedent basis. It is also unclear where this "next step" is generated, received from, or otherwise disseminated in order to determine this "next step".

Furthermore, it is unclear what email the limitation "the email referring to. This limitation also appears to have insufficient antecedent basis.

Claims 39-41 recite "define the next email address". There is insufficient antecedent basis for this limitation in the claim. It is also unclear where this "next email address" is generated, received from, or otherwise disseminated in order to determine this "next email address".

Claims 39-41 recite "update the email address to the next email address". It is unclear where or to what element this "updating" occurs.

Claims 39-41 recite "an out-box adapted to send the email...to the next email address". It is unclear how the email which has a previously set recipient can be sent to the "next email address".

Claims 39-41 recite "an out-box adapted to send email..." The limitation "email" has insufficient antecedent basis.

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Claims 39-41 recite "wherein the email includes a project control field..." It is unclear whether this "email" is either a newly recited email or is referred to the above recited email.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 32 and also claims 33-38 by way of their dependency from claim 32 are rejected under 35 U.S.C. 102(b) as being anticipated by "Teach Yourself Microsoft Project 2000 in 24 hours" ("Project 2000"). See also MPEP 2133.01 and *Paperless Accounting v. Bay Area Rapid Transit System*, 804 F.2d 659, 665, 231 USPQ 649, 653 (Fed. Cir. 1986).

Regarding claim 32, "Project 2000" discloses a workflow project management system, comprising a form route manager ("Messaging Application Programming Interface email system" which includes "Outlook" and "Exchange"; page 497, specifically the paragraph beginning "To communicate by email...") for receiving and sending email according to a route ("routing slip"), the route comprising a step-by-step sequence of email

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addresses (page 509, specifically "The initial sender designates an order in which the file is to be circulated..." and "Choose One after Another to have the file travel sequentially to each recipient"), and communicating with a project management system ("Project 2000"), wherein the form route manager includes an in-box adapted to receive email; a first sequencer adapted to as follows: compare a step field of the email with the route, define the next email address based on the compare, update the email address to the next email address, update the step field to the next step; and an out-box adapted to send mail to the next email address (page 509, "Using the Routing Slip", specifically "A routing slip allows you to circulate the same project file from one recipient to another...The initial sender designates an order in which the file is to be circulated...No recipient receives the file until the previous recipient; eventually, the file is sent back to the originator."), wherein the form route manager sends a message to the project management system at a project segment. (page 509-510, specifically "Using the Routing Slip", more specifically "eventually, the file is sent back to the originator")

Regarding claim 33, "Project 2000" discloses the workflow project management system of claim 32, wherein the message



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includes the time the message was sent (page 501, Figure 23.2, "Date").

Regarding claim 34, "Project 2000" discloses the workflow project management system of claim 32, wherein the message contains a segment identifier. ("Task Name"; page 501, Figure 23.2)

Regarding claim 35, "Project 2000" discloses the workflow project management system of claim 32, wherein a workflow route is associated with a project segment. (page 500, specifically "When team members have been assigned to tasks in a project, the team members must be notified of those assignments.")

Regarding claim 36, "Project 2000" discloses the workflow project management system of claim 32, wherein the project management system calculates the project schedule based on the message. (page 500, specifically "the manager opens the response and updates the project with the team member's response"; page 505, specifically "A workgroup member can send a status update on any task assigned to him or her, whether or not the manager has requested a TeamStatus report")

Regarding claim 37, "Project 2000" discloses the workflow project management system of claim 32, wherein the message is an email message. (page 497, specifically "Communicating with a Workgroup by Email")

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Regarding claim 38, "Project 2000" discloses the workflow project management system of claim 32, wherein a workflow is initiated when a project segment is initiated or completed. (page 500, specifically "When team members have been assigned to tasks in a project, the team members must be notified of those assignments.")

### **Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to George C. Neurauter, Jr. whose telephone number is 571-272-3918. The examiner can normally be reached on Monday-Friday 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn, can be reached on 571-272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/George C. Neurauter, Jr./

Primary Examiner, Art Unit 2143